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WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP			GILLIGAN, CHRISTOPHER L	
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BOSTON, MA 02109			PAPER NUMBER	
			3626	

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/706,101	Applicant(s) HAYES, FRANCIS E.	
	Examiner Luke Gilligan	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8, 10-28, 33 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 10-28, and 33-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/2/06 has been entered.

Response to Amendment

2. In the amendment filed 3/2/06, the following has occurred: claims 1-3, 6-7, 11, 15, 17, 19-25, 27-28, and 33-34 have been amended, while 29-32 remain withdrawn. Now, claims 1-3, 5-8, 10-28, and 33-34 are presented for examination.

3. The Examiner withdraws the rejections under 35 U.S.C. 112 based on Applicant's response.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 6, 7, 19, 21-23, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scheinuk et al., U.S. Patent Application Publication No. 2002/0198745 in view of <http://www.acords.com> (Pages generated through <http://www.archive.org> dated no later than 02/03/1999, pages numbered by Examiner, hereinafter referred to as Choices).

Art Unit: 3626

6. As per claim 1, Scheinuk teaches a system for generating a certificate of insurance, relative to an insured party, for a third party-requester who is not the insured party or an insurer or an insurance producer, relative to the insured party, comprising: a database storing insurance coverage information about each of a plurality of insured parties (see paragraph 0009); and a computer system communicably coupled to the database, the computer system including computer program instructions to: a) provide a first user interface to accept, from a first user, an identification of one of the plurality of insured parties and information identifying a third party who is to be authorized to receive a certificate of insurance, relative to the one of the plurality of insured parties (see paragraphs 0044-0045); b) determine if the first user is authorized to enter information into the database (see paragraph 0079); c) if the first user is authorized, store information about the third-party the database in association with the one of the plurality of insured parties (see paragraph 0089). Scheinuk further teaches an interface to accept identification of a third-party requester from an insurance agent or insurer, and providing the third-party requester with a certificate of insurance (see paragraph 0045).

7. Scheinuk does not explicitly teaches the recited functions d) – f). However, Choices describes a system for generating certificates of insurance that includes the functions of: providing a user interface to accept user credentials and an identification of one of the plurality of insured parties from a third-party requester, wherein the second user interface is accessible by at least a user who is not the one of the plurality of insured parties or an insurance producer or an insurer, relative to the one of the plurality of insured parties (see page 2, in particular, “Certs OnCall” enables a third-party requester to identify themselves as well as an insured through the use of a supplied password); determine if the third-party requester is authorized to generate a certificate of insurance, relative to the one of the plurality of insured parties, comprising determining if the user credentials accepted from the third-party requester by the

Art Unit: 3626

second user interface correspond to the information about the third-party stored in association with one of the plurality of insured parties (see pages 2 and 4); and if the third-party requester is authorized, generate a certificate of insurance relating to the one of the plurality of insured parties and provide the generated certificate of insurance to the third-party requester (see page 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this functionality into the system of Scheinuk. One of ordinary skill in the art would have been motivated to incorporate this functionality for the purpose of further reducing the burden on insurance agency personal by providing immediate web-based access to certificates to certificate holders (see paragraphs 0006-0007 of Scheinuk).

8. As per claim 2, Scheinuk in view of Choices teaches the system of claim 1 as described above. Scheinuk further teaches the database is operable to store information about a plurality of passwords corresponding to at least one of the plurality of insured parties, each of the passwords being associated with a different subset of the insurance coverage information about the at least one of the plurality of insured parties (see paragraph 0049 and Table 2); and the second user interface is operable to accept a password from the second user and to generate the certificate of insurance such that the generated certificate of insurance contains a subset of the insurance coverage information associated with the entered password (see paragraph 0061). As described above, Scheinuk does not provide the direct access to the third-party requester. However, this functionality is described by Choices as described above. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this functionality into the system of Scheinuk for the reasons given above with respect to claim 1.

9. Claims 6 and 7 recite substantially similar method limitations to those already addressed in system claims 1 and 2 and, as such, are rejected for similar reasons as given above.

Art Unit: 3626

10. As per claim 19, Scheinuk in view of Choices teaches the system of claim 1 as described above. Scheinuk further teaches the first user interface is operable to accept an identification of at least one type of insurance carried by the one of the plurality of insured parties and to store the at least one type of insurance in the database in association with the one of the plurality of insured parties (see paragraph 0065); the second user interface is operative to: display only the at least one type of insurance corresponding to the one of the plurality of insured parties (see paragraph 0066); allow the second user to select at least one of the displayed at least one type of insurance (see paragraph 0066); and the computer system is operative to generate the certificate of insurance based on the selected at least one type of insurance (see paragraph 0069). As described above, Scheinuk does not provide the direct access to the third-party requester. However, this functionality is described by Choices as described above. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this functionality into the system of Scheinuk for the reasons given above with respect to claim 1.

11. As per claim 21, Scheinuk in view of Choices teaches the system of claim 19 as described above. Scheinuk further teaches the first user interfaces is operative to input an indication that the words "Endeavor to" may be omitted from a cancellation clause in a certificate of insurance associated with the one of the plurality of insured parties and to store the indication in the database in association with the one of the plurality of insured parties (see paragraph 0062); and the computer system is operative, responsive to the association of said indication with said insured party, for preventing removal of the words "Endeavor to" in a cancellation clause of the generated certificate of insurance (see paragraph 0062).

12. As per claim 22, Scheinuk in view of Choices teaches the system of claim 19 as described above. Scheinuk further teaches the first user interface is operative to present a list

Art Unit: 3626

of insurance options that includes those listed and to permit the first user to select at least one of the list of insurance options and the computer system is operative to store the selected at least one insurance option in the database in association with the one of the plurality of insured parties (see paragraph 0071); the second user interface is operative, responsive to the selected at least one insurance option to display only the selected at least one insurance option (see paragraph 0066).

13. As per claim 23, Scheinuk in view of Choices teaches the system of claim 19 as described above. Scheinuk further teaches the first user interface is operative to input revised additional insured wording to be included in the generated certificate of insurance (see paragraph 0071); and the computer system is operative to insert the revised wording into the generated certificate of insurance in response to an indication of an additional insured option by the second user (see paragraph 0071). As described above, Scheinuk does not provide the direct access to the third-party requester. However, this functionality is described by Choices as described above. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this functionality into the system of Scheinuk for the reasons given above with respect to claim 1.

14. As per claim 33, Scheinuk in view of Choices teaches the system of claim 2 as described above. Scheinuk further teaches providing a third user interface to accept, from a third user, at least one password and an identification of a subset of the insurance coverage information stored in the database and associated with the third user and to associate the at least one password with the identified subset of the insurance coverage information (see paragraph 0049 and Table 2).

Art Unit: 3626

15. Claims 3, 5, 8, 10, 24-26, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scheinuk et al., U.S. Patent Application Publication No. 2002/0198745 in view of <http://www.acords.com> (details as described above) and further in view of Luchs et al., U.S. Patent No. 4,831,526.

16. As per claim 3, Scheinuk in view of Choices teaches the system of claim 1 as described above. Scheinuk further teaches the database is operable to store information about an approving party corresponding to at least a subset of the insurance coverage information corresponding to at least one of the plurality of insured parties (see paragraph 0049); and the computer system is operative to send an electronic message prior to generating the certificate of insurance, the electronic message including at least a portion of a proposed certificate of insurance and to generate a certificate of insurance (see paragraph 0089). Scheinuk does not explicitly teach only generating a certificate of insurance if an approval response is received from the approving party. Luchs teaches only generating an insurance document if an approval response is received from an approving party (see column 6, lines 13-24). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the system of Scheinuk. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of reducing errors in the generation of certificates of insurance by first checking with an approving party (See paragraph 0006 of Scheinuk).

17. As per claim 5, Scheinuk in view of Choices and Luchs teaches the system of claim 3 as described above. Scheinuk further teaches the at least a portion of the proposed certificate of insurance included in the electronic message is modifiable by the approving party and the generated certificate of insurance is generated according to modifications made by the approving party (see paragraphs 0089-0090).

Art Unit: 3626

18. Claims 8 and 10 recite substantially similar method limitations to those already addressed in system claims 3 and 5 and, as such, are rejected for similar reasons as given above.

19. Claims 24-26 contain substantially similar additional limitations to those already addressed in claims 3 and 5 and, as such, are rejected for similar reasons as given above.

20. Claim 34 recites substantially similar additional limitations to those already addressed in claim 3 and, as such is rejected for similar reasons as given above.

21. Claims 11-18 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scheinuk et al., U.S. Patent Application Publication No. 2002/0198745 in view of <http://www.acords.com> (details as described above) and further in view of Grow, U.S. Patent No. 6,694,315.

22. As per claim 11, Scheinuk in view of Choices teaches the system of claim 1 as described above. Scheinuk further teaches the second user interface is operative to accept proposed text to be entered into the generated certificate of insurance and enter a complete sentence into the generated certificate of insurance such that the complete sentence is not modifiable by the second user (see paragraph 0062). Scheinuk does not explicitly teach a box receiving text and forming complete sentences to be entered in said box. Grow teaches an automated document creation system that includes boxes for entering text to be automatically entered in legal documents (see column 6, lines 23-42). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Scheinuk. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of enhancing the efficiency of the document creation process within Scheinuk

Art Unit: 3626

and to provide custom tailored application for different entities within the document creation process (see column 2, lines 1-4 of Grow).

23. As per claim 12, Scheinuk in view of Choices and Grow teach the system of claim 11 as described above. Scheinuk further teaches the second user interface is responsive to whether or not any text was entered (see paragraph 0089).

24. As per claim 13, Scheinuk in view of Choices and Grow teach the system of claim 11 as described above. Scheinuk does not explicitly teach forming a complete sentence responsive to a selected one of a plurality of items listed within a pull down menu. Grow teaches forming complete sentences responsive to a selected one of a plurality of items listed within a pull down menu (see column 12, lines 21-33). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Scheinuk for the reasons given above with respect to claim 11.

25. As per claim 14, Scheinuk in view of Choices and Grow teach the system of claim 13 as described above. Scheinuk does not explicitly teach said pull down menu is one of a plurality of pull down menus, wherein each pull down menu is associated with an insurance type. Grow teaches said pull down menu is one of a plurality of pull down menus, wherein each pull down menu is associated with a predetermined event (see column 12, lines 21-33). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Scheinuk for the reasons given above with respect to claim 11.

26. Claims 15-18 recite substantially similar method limitations to those already addressed in system claims 11-14 and, as such, are rejected for similar reasons as given above.

27. Claims 27-28 recite substantially similar additional limitations to those already addressed in claims 11-12 and, as such, are rejected for similar reasons as given above.

Art Unit: 3626

28. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scheinuk et al., U.S. Patent Application Publication No. 2002/0198745 in view of <http://www.acords.com> (details as described above) and further in view of McKee et al., U.S. Patent No. 6,272,482.

29. As per claim 20, Scheinuk in view of Choices teaches the system of claim 19 as described above. Scheinuk further teaches the second user interface is operable to a input a requested number of cancellation days (see paragraph 0067). Scheinuk does not explicitly teach inputting a maximum and minimum number of cancellation days for comparison to a requested number of cancellation days and comparing this data to produce the error messages. McKee teaches the use of business rules to establish a maximum and minimum number of cancellation days (see column 4, lines 38-51). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these rules into the system of Scheinuk. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of complying with state laws regarding cancellation (see column 4, lines 61-66 of McKee).

Response to Arguments

30. In the remarks filed 3/2/06, Applicant argues in substance that none of the applied prior art, and Scheinuk in particular, teaches a system that enables a third-party to request and receive a certificate of insurance as recited in the amended claims. In response to Applicant's arguments, the Examiner agrees with the assessment that Scheinuk provides a system that enables an insured or insurance agent to access certificates of insurance to forward to third-party requesters. However, the Examiner has now relied upon a new grounds of rejection in view of the Choices reference detailed above. It is respectfully submitted, therefore, that these arguments are now moot in view of the new grounds of rejection detailed above.

Conclusion

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Hancock describes several web sites that provide certificate of insurance functionality.
- Hale describes an automated system for generating certificates of insurance.
- Malecki describes information related to certificates of insurance.

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

33. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

34. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 09/706,101

Page 12

Art Unit: 3626

6/22/06


C. LUKE GILLIGAN
PATENT EXAMINER